

## REMARKS

This application has been reviewed in light of the Office Action dated February 13, 2004. Claims 1, 3, 4, 41, and 54-60 are presented for examination. Claims 1, 41, and 58, the independent claims, and Claim 3 have been amended to define still more clearly what Applicants regard as their invention. Claims 59 and 60 have been added to provide Applicants with a more complete scope of protection. Favorable reconsideration is requested.

Applicants reiterate their remarks from the Amendment After Final Action filed December 10, 2003, regarding the Information Disclosure Statement (IDS) filed November 13, 2002. Applicants respectfully point out that the form PTO-1449 attached to the Office Action dated September 10, 2003, was from the IDS filed on October 29, 2002 and not from the November 13, 2002 submission. The October 29, 2002 IDS contained a typographical error, incorrectly listing Japanese Patent Yasuo "JP 11-707378". The November 13, 2002 submission was a Submission Of Corrected PTO-1449 Form, to correct the typographical error in the PTO-1449 Form submitted with the October 29, 2002 Information Disclosure Statement, and that correctly listed Japanese Patent --JP 11-070378--. Copies of the October 29, 2002, and the November 13, 2002 submissions are enclosed. Accordingly, it is again requested that the corrected entry, namely Japanese Patent Yasuo JP 11-070378 on the PTO-1449 Form from the November 13, 2002 submission be initialed and returned.

Claims 1, 3, 4, and 58 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,978,774 (*Rogers et al.*), as well as being rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rogers et al.* Claim 1, 3, 4, 41, and 54-58 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Publication 2002/0002492 A1

(*Okazawa*). Claims 41 and 54-57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rogers et al.* in view of U.S. Patent No. 5,978,774 (*Hastings et al.*).

As is described more extensively in the present application, toner and other consumable office supplies are manufactured and used on a very large scale. Because some portions of these products (for particular example, the containers in which toner is supplied) are themselves made of recyclable materials, it is desirable for a user to be able to return the container after the toner has been used up. Such returns, however, are typically conducted when the occasion arises, which sometimes involves an inefficient use of both the user's and the manufacturer's (or dealer's) resources. The present invention is intended to provide a more efficient way for a user to return such recyclables.

The aspect of the present invention set forth in Claim 1 is a processing method of ordering and returning consumables, being performed by an information processing apparatus capable of communicating with a terminal via a communication network. The method includes transmitting input screens containing data fields to be displayed on the terminal, allowing a user to input data into the data fields to order a consumable, and to specify the return of a used consumable. The method also includes setting a flag in a memory unit of the information processing apparatus. The flag reflects the data inputted by the user into the data fields to order consumables and to specify the return of the used consumable. The method further includes transmitting display data to the terminal. The transmitted display data includes a message to prompt the user concerning the return of the used consumable, in a case when the flag is set in the setting step indicating that the return of the used consumable was not specified. In the case when the flag set in the setting step indicates that the return of the used consumable was specified, the display data includes a message indicating a history

regarding the return of the used consumable by the user and an incentive point corresponding to the history regarding the return of the used consumable.

Among other notable features of Claim 1 is transmitting display data to the terminal, where the transmitted display data includes a message to prompt the user concerning the return of the used consumable, in a case when the flag is set in the setting step indicating that the return of the used consumable was not specified. When the flag set in the setting step indicates that the return of the used consumable was specified, the display data includes a message indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history regarding the return of the used consumable.

The object of the present invention is to promote the return consumables, improve the recycling of parts of the returned consumables, and to protect the environment by reducing the amount of waste buildup of consumables. To achieve these objects, the present invention, as recited in Claim 1, transmits display data including a message (Message 104 shown in Figure 6) to prompt a user concerning the return of used consumables when the user specifies the return of used consumables. When a user does not specify the return of used consumables, the present invention, as recited in Claim 1, transmits display data including a message (Message 105 shown in Figure 9) indicating a history regarding the return of used consumables and an incentive point corresponding to the history regarding the return of used consumables.

*Rogers et al.* relates to a system for determining whether a product from a consumer may be returned. A central computer system 14 stores management information, such as a retailer's name, registration date, and the last date when warranty repairs and the like are possible. This information is linked to the serial number information of a product. When a consumer returns a product to a store, the serial number information of the product is

scanned and a local computer system 6 obtains the management information from the general database 16, based on the scanned serial number information. The local computer system 6 provides the obtained information to a store clerk who will make a determination whether the consumer is allowed to return the product based on the obtained information. That is, *Rogers et al.* is merely concerned with products returned to a store by a consumer and whether the consumer is authorized to return the product. In contrast, the present invention, as recited in Claim 1, is concerned with ordering consumables and specifying the return of used consumables, such that method of Claim 1 prompts the user concerning the return of used consumables.

However, nothing has been found in *Rogers et al.* that would teach or suggest transmitting display data to the terminal, where the transmitted display data includes a message to prompt the user concerning the return of the used consumable, in a case when the flag is set in the setting step indicating that the return of the used consumable was not specified, and when the flag set in the setting step indicates that the return of the used consumable was specified, the display data includes a message indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history regarding the return of the used consumable, as recited in Claim 1.

For at least the above reason, Applicants submit that Claim 1 is clearly patentable over *Rogers et al.*

The aspect of the present invention set forth in Claim 41 is a processing method of ordering and returning consumables, being performed by an information processing apparatus capable of communicating with a terminal via a communication network. The method includes receiving user log-in information from the terminal, and reading status information which includes history information regarding a used consumable returned by a

user from a database in accordance with the user log-in information. The method also includes transmitting data, which includes ordering information of a consumable, a part of the history information regarding the used consumable returned by the user, and incentive point information which is based on the history information regarding the used consumable, to the terminal for display.

Among other notable features of Claim 41 is transmitting data, which includes ordering information of a consumable, a part of the history information regarding the used consumable returned by the user, and incentive point information which is based on the history information regarding the used consumable, to the terminal for display.

Applicants submit that a *prima facie* case of obviousness has not been made out as to Claim 41 in regards to the rejection of this claim under 35 U.S.C. § 103(a) as being unpatentable over *Rogers et al.* in view of *Hastings et al.* A *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's own disclosure (M.P.E.P. § 2143).

As discussed previously, *Rogers et al.* relates to a system for determining whether a product from a consumer may be returned. Applicants submit that nothing has been found in *Rogers et al.* that would teach or suggest transmitting data, which includes ordering information of a consumable, a part of the history information regarding the used consumable returned by the user, and incentive point information which is based on the history

information regarding the used consumable, to the terminal for display, as recited in Claim 41.

Accordingly, for at least the above reason, Applicants submit that Claim 41 is clearly allowable over *Rogers et al.*, taken alone.

Further, nothing has been found in *Hastings et al.* that would remedy the deficiencies of *Rogers et al.* *Hastings et al.* relates to the rental of items by a consumer. In the *Hastings et al.* system, a consumer is restricted to the number of items that may be rented at any given time. If the consumer attempts to rent more items than authorized, the *Hastings et al.* system does not allow delivery of those items. In the Office Action, the Examiner has attempted to equate the return of a video to one incentive point. Applicants disagree with this understanding of *Hastings et al.* The *Hastings et al.* system merely allows a consumer to receive additional videos when his/her account is not "maxed out". Further, the incentive point information of Claim 41 is not concerned with how quickly a user returns a used consumable, as is implied by the Examiner. Applicants submit that nothing has been found *Hastings et al.* that would teach or suggest transmitting data, which includes ordering information of a consumable, a part of the history information regarding the used consumable returned by the user, and incentive point information which is based on the history information regarding the used consumable, to the terminal for display, as recited in Claim 41.

Applicants further submit that there is suggestion or motivation, either in the references themselves, *Rogers et al.* and *Hastings et al.*, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, because in *Rogers et al.* a determination is made whether a consumer is authorized to return a purchased item and in *Hastings et al.* a consumer rents items from a provider. Thus, the systems of *Rogers et al.* and *Hastings et al.* are used for two totally different

reasons. Accordingly, Applicants submit, therefore, that a *prima facie* case of obviousness has not been made out.

Further, nothing has been found in *Rogers et al.*, *Hastings et al.*, or any permissible combination that would teach or suggest transmitting data, which includes ordering information of a consumable, a part of the history information regarding the used consumable returned by the user, and incentive point information which is based on the history information regarding the used consumable, to the terminal for display, as recited in Claim 41.

The aspect of the present invention set forth in Claim 58 is a processing method of returning a used consumable, being performed by an information processing apparatus capable of communicating with a terminal via a communication network. The method includes receiving user log-in information from the terminal, and reading result information, which includes history information regarding the used consumable returned by a user of the terminal, from a database in accordance with the user log-in information. The method also includes providing information containing a part of the history information regarding the used consumable returned by the consumer and incentive point data to the terminal for display, where the information processing apparatus determines the incentive point data is based on the history information.

For reasons substantially similar as those discussed above in regards to Claim 41, Applicants submit that Claim 58 is clearly patentable over *Rogers et al.*

Furthermore, Applicants submit that rejected Claims 1, 3, 4, 41, and 54-58 are patentable over *Hastings et al.* and *Okazawa* for at least the reason that *Hastings et al.* and *Okazawa* do not qualify as prior art against those claims of the present application.

Sworn translations of Japanese Application 2000-035938, filed on February 14, 2000, and Japanese Application 2000-035937, filed on February 14, 2000, from which the present application claims priority are in preparation, and will be forwarded to the Patent and Trademark Office in the near future. Applicants submit that Claims 1, 3, 4, 41, and 54-58 are supported by priority applications 2000-035938 and 2000-035937. Accordingly, the filing of the sworn translations of these priority applications will remove *Hastings et al.* and *Okazawa*, which have filing dates of April 29, 2000 and May 10, 2001, respectively, as prior art against the Claims 1, 3, 4, 41, and 54-58. Accordingly, Applicants respectfully request withdrawal of the rejections based on *Hastings et al.* and *Okazawa* for Claims 1, 3, 4, 41, and 54-58. If the Examiner receives this response prior to receiving the sworn translations of the above-mentioned priority documents, Applicants respectfully request the Examiner contact Applicants' representative at the telephone number given below.

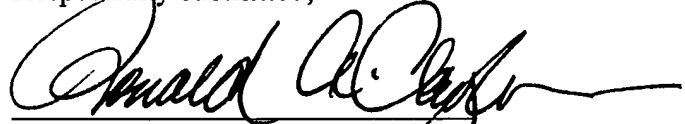
The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully requests favorable reconsideration and early passage to issue of the present application.



Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Donald A. Scinto", written over a horizontal line.

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